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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/727,218 | 12/03/2003 | Felix Galeev | FG-1 | 5399 |

26299 7590 07/28/2005

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| EXAMINER |
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CAMPBELL, KELLY E

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| ART UNIT | PAPER NUMBER |
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3618

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,218

Applicant(s)

GALEEV

Examiner

Kelly E. Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/05/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2,5,7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petell (US 5,738,360) modified by Blankenburg et al (US 5,207,454).

Petell et al teaches an in-line skate including:

a frame (18) having a curved lower portion, see Figure 1, 5a and 5b

a front end and tail end;

attachment means (66,68) to secure to a boot (12);

a point stop (30) at the front end that is a roller (30) fixed in position, see Column 3, lines 18-30, via removable pin or bolt (36), since any bolt is essentially removable;

a plurality of rollers (20,22,24 or first, intermediate and last) spaced apart evenly and located behind the stop (30) along the curved portion of the frame (18);

and the lower curved portion of the frame (18) defining a curvature sufficient to allow support of the skate only by the point stop (30) and the front wheel (20), see Figure 3.

Petell does not teach the use of a front and tail ball configuration.

Blankenburg et al teaches an in-line roller (10) with various embodiments combining wheel rollers (32) and ball supports (40,42,46,44);

wherein a front ball support (40) is located at the front end of the skate frame (18) ahead of the wheel roller (32) and wherein a tail ball support (44) behind the roller (32), see Column 4, lines 13-16;

wherein the ball supports include a housing (54) supports ball rollers (70) allowing for free rotation within the housing (54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate having an point stop as taught by Petell, to include ball supports strategically placed in front and behind the roller wheels, as taught by Blankenburg, in order to provide a skate maneuverable in more than just a straight-forward-backward movement, allowing the user to various maneuvers , spins, turns, which have been hereto difficult with conventional in-line skates.

With regards to the distance between the rollers being greater than the distance between the first rotating roller and front ball support, it has been held that the rearranging parts of an invention involves only routine skill in the art, *In re Japiske*, and the invention would work equally well, with the spacing between rollers, being equal.

With regards to the specific distance in inches between wheels, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a distance between wheel of 1-3 inches or a distance that would accommodate the size of the skate frame and the user's foot length, since it has been held that where

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the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 1 and 5,7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (US 1,868,548) modified by Blankenburg et al (US 5,207,454).

Turner teaches an in-line skate including:

a frame (7) having a curved lower portion, see Figure 1;

a front end and tail end;

attachment means (9) to secure to a boot (1);

a point stop (29) at the front end that is a tapered bushing fixed in position.

a plurality of rollers (13-20) spaced apart evenly and located behind the stop (29) along the curved portion of the frame (7);

and the lower curved portion of the frame (7) defining a curvature sufficient to allow support of the skate only by the point stop (29) and the front wheel (20), see Figure 1.

Turner does not teach the use of a front and tail ball configuration.

Blankenburg et al teaches an in-line roller (10) with various embodiments combining wheel rollers (32) and ball supports (40,42,46,44);

wherein a front ball support (40) is located at the front end of the skate frame (18) ahead of the wheel roller (32) and wherein a tail ball support (44) behind the roller (32), see Column 4, lines 13-16;

wherein the ball supports include a housing (54) supports ball rollers (70) allowing for free rotation within the housing (54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate having an point stop as taught by Turner, to include ball supports strategically placed in front and behind the roller wheels, as taught by Blankenburg, in order to provide a skate maneuverable in more than just a straight-forward-backward movement, allowing the user to various maneuvers , spins, turns, which have been hereto difficult with conventional in-line skates.

Response to Arguments

Applicant's arguments filed 5/05/05 have been fully considered but they are not persuasive. With regards to applicant's arguments that the Petell and Blankenburg references do not allow a user to perform all maneuvers done with ice skates, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., able to perform certain types of maneuvers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

From MPEP 2111: During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*,

211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

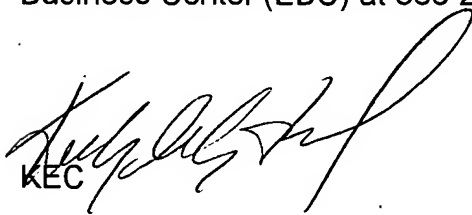
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly E. Campbell whose telephone number is (571) 272-6693. The examiner can normally be reached on 9:00-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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